

REMARKS

Claims 1 - 20 remain active in this application. Claims 3 and 4 have been amended to more closely correspond to the text of the specification at page 17, line 25. No new matter has been introduced into the application.

The explicit withdrawal of numerous grounds of rejection objection and requirements from the previous office action is noted with appreciation. In this regard, however, the withdrawal of previous grounds of rejection, particularly based on prior art, is clearly indicative of the impropriety of such grounds of rejection and thus similarly indicative of the premature finality of the present action due to both the failure to make a *prima facie* demonstration of the propriety of grounds of rejection in the prior action and the failure to show that new grounds of rejection were necessitated by amendment (as well as failure to make a *prima facie* demonstration of propriety of grounds of rejection raised in the present action) as will be discussed more fully below.

The Examiner denies the claim of priority of Provisional U. S. Patent application 60/155,010 and appears (in paragraph 5 of the present action) to have adhered to the original rejection of claims 1 - 20 under 35 U.S.C. §102 as being anticipated by that provisional application. The Examiner has now clarified the asserted difference in inventorship by making the observation that inventor Mimi Nguyen, named in the provisional application, is not a named inventor in the present application. The position taken by the Examiner and this ground of rejection (if, in fact, made, as it appears to be) are respectfully traversed.

The Examiner's assertion and observation and the rejection are clearly incorrect based upon evidence provided by the Examiner in the previous office action.

Specifically, the Examiner cited (reference X, PTO-892, sheet 1 of 3, asserting an apparently incorrect date of publication) an article (apparently published in 2000, as shown in the SE & the Internet Interest Group list of papers, attached, and corroborated by an internal reference in the article to the publication of another article in 2000) entitled "Exploiting the Collaborative Engineering Environment as a Critical Resource Multiplier" by Kenneth N. Myers and Quynh-Anh (Mimi) Nguyen (both named inventors in the present application and for whom biographical notes have been provided in the article) including Figures similar to Figures 8 - 10 of the present application. Therefore, this article, cited by the Examiner, establishes that "Mimi" Nguyen and Quynh-Anh Nguyen are, in fact, one and the same person and that information was available to the Examiner at the time of the previous office action in this application.

While efforts to reach inventor Nguyen have been unsuccessful to date, a statement or declaration from another joint inventor that "Mimi" Nguyen and Quynh-Anh Nguyen are one and the same person can be provided, if required. However, it is abundantly evident from evidence provided by the Examiner that inventor Nguyen of the provisional application has not, in fact, been omitted as an inventor of the present application. It follows that the inventorship of the provisional application 60/155,010 and utility application 009/666,545 are the same, the priority of the provisional application can be and has been properly claimed in the present application and the provisional application is unavailable as a reference against the present application. Therefore, reconsideration and withdrawal; of the denial of priority based on the provisional application and the rejection for anticipation by the provisional application are respectfully requested.

In this regard, it is noted that the Examiner also asserts (paragraph 14 of the present office action, *without making a rejection*), that the claim for domestic priority is also denied because the provisional application fails to provide adequate support for the claimed subject matter of the present application, *diametrically contrary to the asserted rejection of all claims for anticipation*. This assertion is respectfully traversed.

Initially, it is respectfully submitted that the Examiner's assertion is gratuitous and potentially prejudicial. In a claim for domestic priority, the claimant is entitled to priority of whatever subject matter is properly and sufficiently disclosed in the provisional application. Therefore, it follows that any subject matter sufficiently disclosed to support a rejection as prior art is not available against the present application and, conversely, subject matter not sufficiently disclosed to support a claim of priority would also be insufficient to support a rejection as prior art. In either case, no grounds for rejection arise and the issue is completely moot in the absence of a reference of intervening date which is not the case here; Hara and McQuay, applied under 35 U.S.C. §102 in paragraph 18 of the present office action having publication dates of 1997 and 1998, respectively. Therefore, the Examiner's assertion is clearly gratuitous and potentially prejudicial.

Substantively, the Examiner's assertion is clearly in error. The provisional application is clearly directed to the provision of a catalog as an enhancement for an object oriented database management system with which it is used in combination for collection and distribution of information and specifications at the parts level of a project or enterprise of arbitrary complexity. Section 2.4 discusses the constitution and processes of the

creation, modification and use of the catalog in detail and provides three detailed flow charts in which Figure 1 illustrates the catalog change process, Figure 2 illustrates product model development using the catalog including the creation and modification/customization of parts and the product model release process using the catalog and changes therein. This subject matter, recited in the claims in regard to "part objects" (e.g. default values of part specifications) and "part references" (e.g. customized/modified values of part specifications) is clearly disclosed in enabling detail and clearly support the description of the operation of the invention on, for example, pages 28 - 30 and the examples of use of the invention on pages 33 - 42 of the present application, which also clearly support the claimed subject matter. Therefore, it is believed to be abundantly clear that the Examiner's assertion and further denial of the claimed priority of provisional application 60/155,010 is without substantive basis and is thus clearly prejudicial. Accordingly, it is respectfully requested that the Examiner's gratuitous and prejudicial assertion be reconsidered and explicitly withdrawn.

The Examiner has adhered to the rejection of claims 3 and 4 under 35 U.S.C. §112, second paragraph, as being vague; the Examiner acknowledging that an "abstract component type" is defined as an "intangible component" but asserting that no detailed example or explanation of "intangible component" is given. This ground of rejection is respectfully traversed.

The Examiner's attention is respectfully called to page 17, lines 25 - 27, in which the phrase "intangible or abstract part" appears in reference to the scope of "elements" which the invention accommodates and to which literal correspondence of claims 3 and 4 has been improved by the above amendment. The same sentence provides two clear examples of 1.) a process

description defining an operational activity, and 2.) a set of data related to software design; both of which can clearly be both intangible and abstract.

Therefore, the scope of these claims can readily be determined in regard to possible elements which are similarly intangible and/or abstract. Accordingly, it is respectfully submitted that this ground of rejection is untenable and reconsideration and withdrawal thereof are respectfully requested.

The Examiner maintains the rejection under 35 U.S.C. §101 for obviousness-type double patenting. This rejection is again respectfully traversed for the reasons made of record in the previous response, hereby fully incorporated by reference, as confusing statutory and obviousness-type double patenting and as being substantively in error.

The Examiner's attention is also respectfully called to the fact that this application is a continuation-in-part of U. S. Patent Application 09/631,694 which the Examiner relies upon in this ground of rejection. As previously pointed out, that application does not claim the catalog enhancement of the present invention to which all claims of the present application are clearly directed by virtue of the "parts objects" and "parts references" or "identifying parts" and "customizing parts" recitations of independent claims 1 and 11, respectively, the only independent claims in the application. Therefore, it is clear that the claims of the present application cover patentably distinct subject matter from that of 09/631,694 and there is no possible extension of monopoly. Further, the present invention can be used in a generalized CEE environment and, although the environment of 09/631,694 is preferred, does not rely on the particulars thereof to produce the meritorious effects of improved data collection and convenience of data distribution and use. Therefore, the a patent on

the present "catalog" invention cannot have the effect of requiring a license of one invention in order to practice the other or vice-versa and there can be no justification for requiring common ownership as a condition of enforceability. Accordingly, it is respectfully submitted that there is no statutory double patenting issue presented and there is no public interest protection issue present to support a non-statutory, obviousness type double patenting rejection. Accordingly, the rejection is clearly untenable and reconsideration and withdrawal of the same is respectfully requested.

Claims 1 - 20 have been rejected under 35 U.S.C. §103 as being unpatentable over (newly cited) "Hara-H" (Hara et al.) in view of McQuary (sic - McQuay); The Examiner observing that Hara teaches a basic conceptual CEE environment without teaching an application while McQuay teaches application of such a CEE environment to a particular design technology. This ground of rejection is respectfully traversed, particularly since the Examiner has not demonstrated how the applied combination of newly cited references answers the actual recitations of the claims and does not even indicate a basic understanding of the invention, as claimed.

Initially, it is respectfully pointed out that, while the word "catalog" is used in the Examiner's statement of the rejection, the references are silent in regard thereto. Further, it appears that a basic misunderstanding may derive from the fact that information distribution in even a basic CEE system or environment may have some attributes of a real-world catalog document while the concept of a "catalog" as used in the present application is quite different in significant ways which are explicitly recited in the claims and in regard to which, *both* the statement of the rejection and the applied references are silent.

Specifically, it was discovered by the inventors that obtaining and maintaining up-to-date data to specify candidate assemblies in a CEE environment was much more difficult than the design of a product itself using the CEE environment despite a complex user interface. It was also discovered that the this and other difficulties (such as maintaining a history of the design process, product documentation and simulation and other product evaluation processes) resulted from information which was lost when modifications of component/part specifications were made (e.g. one specification substituted for another which is then discarded following such an update) and the limitation of access to subject matter experts which are in demand across the CEE system and the inability to accommodate differing behaviors of a component/part in differing applications; an example given in the specification being a mean time between failures of a part being rated at 100,000 hours in a "ground benign" environment but 120,000 hours in a space flight environment as might be known to or discovered by subject matter experts. Thus, known CEE systems, product-centric or otherwise, did not provide for maintaining "default" values in regard to parts or components while allowing modified or customized values to be collected and thereafter distributed.

The invention solves this problem of the inability to accommodate different behaviors or particular specifications for the same part with a "catalog" which differs from a catalog document in several ways including providing not only "part objects" including basic, "default" values of intrinsic part or component characteristics and referenced to a given part but also "part references" (preferably by additional class of objects) which additionally includes modified or customized values in accordance with a project to which the CEE is applied and referenced to a part object to

override or extend the intrinsic characteristics of the part or component and an arrangement for linking members of the CEE with both the part objects and the part references, as claimed.

Hara et al. is a basic, conceptual description of a CEE environment in which information is distributed as web pages. The Examiner correctly points out that the Abstract of Hara et al. mentions provision of notification of creation or modification of such web pages. The Examiner may have inferred, although Hara et al. does not mention, similarity of such web pages to page of a real-world catalog document. However, such pages, particularly if modifiable are inherently a cause of loss of at least access to earlier data through the CEE environment when such a modification is made even though each page and each modification may be archived. Hara et al. thus does not teach or suggest anything remotely resembling the constitution or function of the claimed "part references" (claim 1) or the step of "customizing existing parts" (claim 11) to "override or extend" part objects or default values of parts, particularly in combination with a parts catalog having the constitution or function claimed and a means or step for distributing both the part objects and the part references to members of the CEE, as claimed, and the Examiner has not suggested or asserted that it does.

Similarly, the Examiner has not suggested or asserted that McQuay et al. contains such a teaching. The Examiner has not addressed the meritorious function of the invention supported by the claimed combination of part objects, part references and linkage of both to CEE members and thus has not asserted that the combined teachings of Hara et al. and McQuay et al. provide evidence of a level of ordinary skill in the art to support a conclusion of obviousness of the claimed combination of elements or steps. On the contrary, it

is clear that the combined teachings of Hara et al. and McQuay et al. do not, in fact, lead to an expectation of success in achieving the meritorious function of the invention in collection of data, leveraging of expertise and systematic re-use of collected data. Even at a very rudimentary level and assuming (*arguendo*) that modifiable web pages may be described as a catalog. A modifiable web page does not answer the claim recitations of the catalog part objects as having *default* values representing intrinsic characteristics of a part or component, much less extending or overriding the default values of the part object with part references or modified or customized characteristics of the object and, in fact, seems to be mutually exclusive thereof simply due to the fact that the web page is modifiable rather than *separately* collecting modifications or customizations as claimed.

Accordingly, it is clearly seen that the asserted ground of rejection based on Hara et al. and McQuay et al. is in error since the combination of teachings does not answer the recitations of any claim in the application. Moreover, since the Examiner does not directly address the actual combination of elements or steps recited, the Examiner has not made a *prima facie* demonstration of obviousness of any claim in the application. Therefore, it is respectfully submitted that the ground of rejection based on Hara et al. and McQuay et al. is untenable and reconsideration and withdrawal thereof are respectfully requested.

Additionally, while the parent application 09/631,694 is not mentioned in the present office action in connection with this rejection of the rejection for double-patenting. It is clear from the above discussion that the claimed invention is not merely an obvious variant on the subject matter claimed in the parent application and the above demonstration of errors in this rejection under 35 U.S.C. §103 even

more clearly indicates that a *prima facie* demonstration of the propriety of the double patenting rejection has not been made.

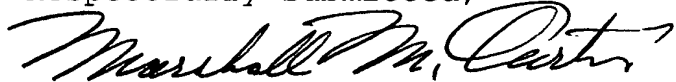
In this regard, it is also respectfully submitted that the finality of the present action is premature. No official action should be made final when it does not contain a *prima facie* demonstration of the propriety of any rejection, objection or requirement therein. On the contrary, it has been demonstrated above that each objection or rejection contained in the present action is *prima facie* in error and that the errors are evident from information before the Examiner when the objections or rejections were made. By the same token, it appears that the Examiner has not yet properly considered the subject matter of the invention, as claimed. Moreover, the Examiner has not, in any way, demonstrated that the new ground of rejection was, in fact, necessitated by amendments which were, rather, directed to matters of form, as indicated by the Examiner's explicit withdrawal of most objections and rejections based on the previously presented remarks and in view of the lack of a *prima facie* demonstration of the propriety thereof in the previous action. Accordingly, it is respectfully submitted that the finality of the present action is premature and is prejudicial since it closes prosecution prior to a proper consideration of the claimed subject matter having been provided. Therefore, withdrawal of the finality of the present action is respectfully requested. Further in this regard, since no amendment has been made to the independent claims in this response, any further adverse action containing any new or modified ground of rejection cannot properly be made final.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered and shown to be in error and/or

inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



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Attachment:

SE & the Internet Interest Group (list of papers)